



W.P.No.8451 of 2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

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Reserved on : 21.02.2024

Pronounced on : 15.03.2024

CORAM : JUSTICE N.SESHASAYEE

W.P.No.8451 of 2023
and WMP.Nos.8647, 8649 & 8650 of 2023

1.E.R.Squibb & Sons LLC
at Route 206 & Province Line Road
Princeton, New Jersey 08540
Represented by its
Constituted Attorney / Authorised Signatory
Mr.Toni Mon George

2.Ono Pharmaceutical Co. Ltd.,
at 1-5, Doshomachi 2-chome
Chuo-ku, Osaka-shi, Osaka 541-8526 Japan
Represented by its
Constituted Attorney / Authorised Signatory
Mr.Toni Mon George

... Petitioners

Vs

1.Union of India
Through the Ministry of Commerce
Department of Industrial Policy &
Promotion Udyog Bhawan
New Delhi - 110 011.

2.The Controller of Patents & Designs
The Patent Office



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Intellectual Property Office Building
G.S.T.Road, Guindy
Chennai - 600 032.

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3.Zydus Healthcare Limited
of Zydus Corporate Park
Scheme No.63, Survey No.536
Khoraj (Gandhinagar)
Nr.Vaishnodevi Circle
Ahmedabad, Gujarat - 382 481.

... Respondents

PRAYER : Writ Petition filed under Article 226 of the Constitution of India praying to issue a Writ of Certiorarified Mandamus calling for the records and quashing the recommendation of the Opposition Board in Patent No.IN340060 (Patent Application No.5057/CHENP/2007) and consequently direct the second respondent to reissue the same after deciding the miscellaneous petition of the petitioner and consider all the documents on record under Rule 57 to 60 of the The Patents Rules, 2003.

For Petitioners : Mr.Archana Shanker
for M/s.Anand and Anand

For Respondents : Mr.Satish Parasaran, Senior Counsel
for Mr.Adarsh Ramanujam for R3

ORDER

The present petition is filed challenging the recommendations of the Opposition Board constituted under Rule 56 of the Patent Rules, 2003 and



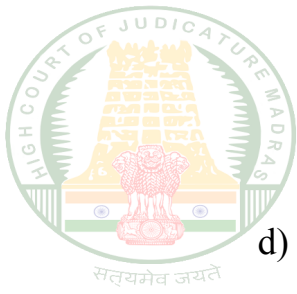
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to quash the same.

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2.1 The facts are:

- a) The petitioners herein are international pharmaceutical companies. On 02.05.2006, they had applied for patenting one of its inventions, and this application invited as many as four oppositions and the Patent Controller had rejected all the four oppositions and granted patent to petitioners' invention on 01.07.2020.
- b) In terms of Sec. 43(2) of the Act, on 03.07.2020, the patent granted to the petitioners came to be published. The third respondent herein responded to it with its opposition, which they have filed on 01.07.2021. Indeed, the third respondent had filed its notice of opposition plus its written statement, but did not choose to file any evidence.
- c) On 01.10.2021, the petitioners herein had filed their reply statement to the written statement of the third respondent along with seven evidences of the experts. Alongside, the petitioners have also taken out an application under Rule 60 of the Patent Rules seeking the leave of the second respondent for producing further evidence.



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- d) While so, on 01.12.2021, the third respondent had filed its rejoinder which comprises of two evidence from the experts. These documents were not filed along with the written statement.
- e) In terms of Rule 59, an opponent is entitled to file only such evidence as is necessary to meet the evidence produced by the patentee. There is no procedural space for filing any re-joinder.
- f) On coming to know of the same, the petitioners herein had taken out another application on 03.08.2022, wherein it objected to the rejoinder filed by the third respondent. In essence, the petitioners required the Controller not to act on the rejoinder produced by the third respondent on 01.12.2021. The petitioners heard nothing from the Controller on this petition.
- g) As stated earlier even on 01.10.2021, the petitioners had filed an application under Rule 60, seeking leave of the Controller under for producing further evidence. The Controller is alleged to have sat over this application without passing any orders. It is in these circumstances without any intention to take any further chance in the matter, on 25.08.2022 the petitioners herein had filed two further evidences.



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WEB COPY 2.2 Under Rule 56 (4), the Opposition Board is required to consider all the documents such as (a) Written statement of the opponent to the grant of patent with evidence filed under Rule 57; (b) Reply statement of the patentee along with the evidence in answer to the written statement of the opponent along with evidence filed under Rule 58; (c) Any evidence filed by the opponent in reply to the evidence of the patentee under Rule 59; and (d) any evidence which any of the parties may file with the leave of the Controller under Rule 60.

2.3 In the instant case, the Patent Controller (a) appeared to have let the Opposition Board to consider the rejoinder of the opponent/3rd respondent for filing which there is no procedural space, without passing any orders on the application filed by the petitioners to reject it, and (b) appear not to have let the Opposition Board consider the additional evidence of the petitioner-patentee for receiving which the petitioner-patentee had filed its petition under Rule 60 seeking leave even along with its reply statement. This is in breach of the statutory requirement contemplated in Rule 57 (4).



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2.4 This apart there is no indication in the recommendations of the

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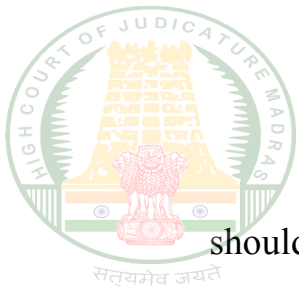
Opposition Board as to when it was filed. The counter says it was filed well before 03.08.2022, but the Controller did not disclose the date when it was made.

3. In its counter, the second respondent/the Controller of patents had stated that the Opposition Board had considered the rejoinder filed by the opponent/3rd respondent under Rule 59, but not the additional evidence filed by the petitioners/patantees under Rule 60. Significantly, the counter states that the Opposition Board had forwarded its recommendations before 03.08.2022, but did not indicate the specific date on which it was so sent.

4. In its counter, the opponent/third respondent had stated that on 01.12.2021, it had filed its rejoinder.

Arguments for the petitioners/patentees:

5. The learned counsel for the petitioners argued that the Opposition Board had (i) considered that which it should not have considered – the rejoinder purportedly filed under Rule 59; and (ii) omitted to consider that which it



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should have considered, namely the additional evidence of the petitioners.

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In both the instances, the Controller of Patents may have to take part of the blame, for he did not pass any orders on the two petitions which the petitioners had filed: (a) one to reject the re-joinder since the Rules do not provide for filing a rejoinder; and (b) the other filed for producing further evidence under Rule 60. And, it is hence the counter of the second respondent is vague and sweeping about the date on which the Opposition Board had filed its recommendations. And, the second respondent would plead that since the petition for rejection of rejoinder was filed after the Constitution of the Opposition Board, the same was not considered. There are at least two flaws here:

(a) Under Rule 56, an Opposition Board is required to be constituted, the day when the Controller receives notice of opposition under Section 25(2). Rule 56(4) stipulates that the Opposition Board should consider the written statement of the party opposing the patent, the reply statement of the patentee, and the evidence filed by the parties under Rules 57 to 60. Here is a situation where notwithstanding the fact that the patentees have filed an application as early as on 01.10.2021 seeking the leave of the Patent Controller to file



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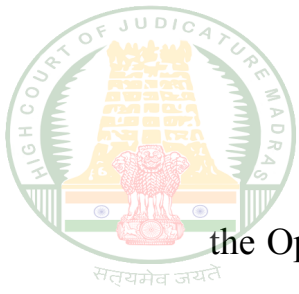
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additional evidence, he has not passed any order and admittedly has not forwarded even the evidence filed under Rule 60.

b) While Rule 56 stipulates or mandates that the Opposition Board shall consider all the evidence filed under Rules 57 to 60, both Rules 56 and 60 are silent as to when exactly the papers should be forwarded by the Controller to the Opposition Board. All that the parties would have to believe is that an Opposition Board might have been constituted on receipt of the notice of opposition, but not when the papers are placed before the Opposition Board by the Controller. Unless it is known, the parties will be in dark as to when exactly they have to file their additional documents. It is hence in anticipation, the patentee had filed the application under Rule 60 along with their reply statement, and non passing of the order by the Patent Controller has led to the present situation.

Arguments of the Respondents:

6. Heard the learned counsel for the respondents. Arguing for the third respondent, Mr.Satish Parasaran, learned senior counsel, submitted that the petition itself is not maintainable on the ground that the recommendations of



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the Opposition Board has only recommendatory value, and it is not binding

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the Controller and hence, it does not provide any cause of action to invoke

Article 226. Secondly, he cautioned that the Courts cannot micro manage

every proceedings before the Patent Controller, and it is important that the

proceedings are taken to its logical end by the Controller. He added that

when the statute had granted power to the Patent Controller and also

delineated how the power must be exercised, it may not be appropriate for

the Court to instruct how the Controller must exercise its authority. Reliance

was placed on the authorities in *Panacea Biotec Limited Vs Union of India*

and Others [2019 SCC OnLine Bom 5316]; *Willowood Chemicals Private*

Limited Vs Assistant Controller of Patents and Designs and another

[Order of the High of Delhi in W.P.(C)-IPD 15/2023 & CM No.34-35/2023

dated 17.03.2023].

Discussion and Decision :

7.1 The rival submissions are carefully weighed. An Opposition Board is

the creation of the statute, and the statute mandates how it should go about

its job. Its statutory duty can be broadly divided into two parts :

- a) the materials which the Opposition Board shall consider; and



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- b) the recommendations it is required to make, pursuant to the examination of the materials that passes its scrutiny.

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7.2 So far as the materials which the Opposition Board is required to consider, they are delineated or listed in Rule 56(4) of the Patent Rules, according to which, all that are filed by the parties under Rule 57 to 60 shall pass the scrutiny of the Opposition Board. This implies it is obligatory on the part of the Controller to place all the materials that the parties had filed under Rule 57 to 60 before the Opposition Board. Once the materials are so placed before the Opposition Board, it is required to examine them and make its recommendations. Any recommendation so made, by its very nature is only recommendatory in character and hence it is for the Controller to decide on the adequacy or completeness of the recommendations of the Opposition Board. Since the recommendations of the Opposition Board is not binding on the Controller, and since the Controller may have to decide on the thoroughness with which the Opposition Board has made its recommendations, the Court may not interfere with the same in judicial review. To this extent this court is in agreement with the submissions of the respondent's counsel. After all the parties will have an opportunity to



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expose or establish the quality of the recommendations of the Opposition

Board as well as its reliability.

7.3 The same however, cannot be extended to any recommendations made by the Opposition Board in breach of Rule 56(4). When the statute mandates what an authority shall consider, then it is obligatory for the statutory authority to consider those materials which the statute mandates. In the instant case, the Opposition Board may not be blamed for it is required to consider only such material which the Controller makes available before it for the former's scrutiny. After all, the Opposition Board constituted under Rule 56 does not and cannot have direct access to such material which the parties are required to file under Rule 57 to 60 before the Controller.

7.4 In this case, two pointed allegations are directed against the Controller. Firstly, he is alleged to have entertained a rejoinder filed by the third respondent when Rule 59 enables only filing of the evidence answering the evidence produced by the patentee under Rule 58, and that the Controller has forwarded the said rejoinder to the Opposition Board without taking any



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decision on the application filed by the patentee/petitioner herein. And the

second allegation is that the Controller did not take a call on the application filed by the patentee seeking leave of the Controller for the production of the additional evidence.

7.5 Admittedly, the Controller had forwarded the rejoinder filed under Rule 59 to the Opposition Board and did not forward the additional evidence of the petitioner filed under Rule 60. Therefore, it cannot be said that the Opposition Board has considered all the materials that it is mandated to consider under Rule 56(4). It must however be stated that these two aspects will essentially depend on the outcome of the two applications which the petitioner had filed as referred to earlier. In fitness of things, the Controller ought to have decided the two applications which the patentee / petitioners have filed. The Controller should have considered whether the document which the third respondent had filed must be treated as a rejoinder, notwithstanding the fact that it is described as a rejoinder, or whether it constitutes contra evidence of the opponent to the evidence of the patentee. This decision will eventually have a bearing on the nature of materials that had passed the scrutiny of the Opposition Board. Turning to the other



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application filed by the petitioner for seeking leave of the Controller for production of additional evidence under Rule 60 is concerned, it is not disputed that the patentee / petitioner had filed this application even along with their reply statement. Now unless an order is passed, the applicant will never know whether leave had been granted for the production of additional evidence.

7.6 Now it becomes an easy conclusion to hold that the failure of the Controller in deciding the two applications referred to above has resulted in the present situation. Set in the context, the recommendations of the Opposition Board in the instant case may not be considered as one based on those materials which it is required to consider under Rule 56(4). The recommendations of the Opposition Board may have to be interfered with, not because it is not warranted due to its recommendatory character, but because its recommendations appear to be a product of improper and/or incomplete scrutiny of materials which it is mandated to consider under Rule 56(4). To sum it up, if the Opposition Board has considered all the materials that it is required to consider under Rule 56(4), then the quality of such recommendations can be considered only by the Controller and not by



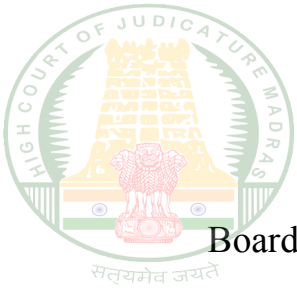
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this Court. If however, the recommendations are made without considering

the materials which are required to be considered, then any recommendations so made cannot be considered as proper recommendation within the statutory scheme, and hence this court can interfere.

7.7 Secondly, in the counter it is indicated that two additional evidence which the petitioners had filed by way of abundant caution had not been considered by the Opposition Board. This is bad in law, because when once the petitioners have taken out an application under Rule 60 and filed it even along with its reply statement as early as on 01.10.2021, in fitness of things, the Controller ought to have passed an order, which he did not. At one level there is a breach of Rule 59 in aid of third respondent, at another level, there is a refusal to look into the two additional evidence produced by the petitioners to their prejudice.

8. In conclusion, this Court allows this petition and sets aside the recommendation of the Opposition Board, and further directs the Controller to decide the two applications filed by the petitioners/patentees after holding an hearing on them, and forward the papers to another Opposition



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Board for making its recommendations. No costs. Consequently, connected

miscellaneous petitions are closed.

15.03.2024

Index : Yes / No

Speaking order / Non-speaking order
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To:

1.Union of India

Through the Ministry of Commerce
Department of Industrial Policy &
Promotion Udyog Bhawan
New Delhi - 110 011.

2.The Controller of Patents & Designs

The Patent Office
Intellectual Property Office Building
G.S.T.Road, Guindy
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N.SESHASAYEE.J.,

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Pre-delivery order in
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